



Paper No. 24

KAREN B DOW
MORRISON & FOERSTER LLP
3811 VALLEY CENTRE DRIVE
SUITE 500
SAN DIEGO CA 92130-2332

COPY MAILED**APR 24 2002****OFFICE OF PETITIONS**

In re Application of
Boehringer, et al.
Application No. 08/812,616
Filed: March 6, 1997
Attorney Docket No. 273102007800

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed on January 7, 2002 (Certificate of Mailing dated November 7, 2001), to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mailing date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." This is **not** a final agency decision within the meaning of 5 USC 704.

The above-identified application became abandoned for failure to timely file a proper response to the final Office action mailed September 1, 2000, which set a shortened statutory period for reply of three months. On March 5, 2001, petitioner (through previous counsel) filed an amendment, made timely by obtaining a three month extension of time and including a Certificate of Mailing dated March 1, 2001. A Notice of Abandonment was mailed on May 8, 2001. In response, petitioner filed a petition to withdraw the holding of abandonment on June 23, 2001, citing the timely filed amendment of March 5, 2001. However, this petition was denied in a decision mailed on August 23, 2001.¹ Accordingly, the above-identified application was abandoned as of March 2, 2001.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d).

¹ The petition was denied because it was determined that the March 5, 2001 amendment did not constitute a bona fide attempt to respond to the final Office action.

The instant petition lacks item (1), the required reply.

With the instant petition, petitioner filed an amendment in response to the final Office action. The proposed reply to a final Office action required for consideration of a petition to revive must be either (1) a Notice of Appeal (and fee required by law); (2) an amendment that *prima facie* places the application in condition for allowance; (3) the filing of a continuing application under 37 CFR 1.53(b) or if applicable, 1.53(d); (4) a request for a continuing examination (RCE) under 37 CFR 1.114; or (5) if applicable, a 37 CFR 1.129(a) submission.

Petitioner's only submission, an amendment, has been determined by the examiner not to *prima facie* place the application in condition for allowance. Thus, petitioner has failed to submit the required reply.

In order for the application to be revived, petitioner must submit a required reply within the meaning of 37 CFR 1.137(b)(1). **Any renewed petition should be accompanied by a proper reply in the form of a Notice of Appeal, the filing of a continuation application or a RCE.** If petitioner fails to reply in the form of a Notice of Appeal (and fee), a proper continuing application, or a proper RCE, it may be construed as an intentional delay in presenting a grantable petition, which may adversely affect petitioner's ability to revive the abandoned application.

The Revocation and Power of Attorney filed on March 5, 2002 is acknowledged and made of record. Future correspondence concerning the above-identified application will be mailed to the above address of record.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0272.



Cliff Congo
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy